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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,296	11/19/2001	Ji Hyun Hwang	MRE-0042	8448

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 07/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,296

Applicant(s)

HWANG ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the invention of Group II, Claims 16-20 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the search for both the inventions of Groups I and II would not place any undue burden on the examiner. This is not found persuasive because there are other factors included in determining a burdensome search. In this case, each of these inventions have different lines of patentability, i.e. an apparatus and a process of making, which would require the applicability of different case law, different art and non-coextensive searches. Because of these factors, the search would be burdensome. Therefore, requirement is still deemed proper and is therefore made FINAL.
2. Claims 1-15 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Specification

3. The abstract of the disclosure is objected to because the abstract is not directed to the claimed invention, i.e. method. Correction is required. See MPEP § 608.01(b).
4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves

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modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.**

Extensive mechanical and design details of apparatus should not be given.

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Surface Mounting Method.

Claim Objections

6. Claims 16-18 and 19 are objected to because of the following informalities: in the preamble of each of Claims 16 and 19, the recitation of "The surface mounting method" would be considered more favorably if it were recited as --A surface mounting method--.

Each of Claims 17 and 18 are awkwardly worded and the following is suggested:

In Claim 17, the term --to-- should be added after "discharged" (line 5).

In Claim 18, the term --to-- should be added after "discharged" (line 5).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 19, the phrase of "the second multi-layer transfer unit" (line 10) lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Burt et al 5,812,693.

Burt discloses a surface mounting method comprising: carrying a printed circuit board 30 to a first multi-layer transfer unit (rework system 40) into a first conveyor 43; discharging the printed circuit board carried to the first conveyor to a second multi-layer transfer unit (PC board buffer unit 41); carrying the printed circuit board discharged to the second multi-layer transfer unit to a second conveyor 49; and discharging the printed circuit board carried to the second conveyor to the first multi-layer transfer unit 40 (shown in Fig. 4). All of the steps above are controlled by the use of controller (computer discussed at col. 3, lines 23+).

Regarding Claims 17 and 18, the printed circuit board can be discharged to the second multi-layer transfer unit 41 in a state that parts (components) are not mounted under control of the controller, but are awaiting to be transferred to the first multi-layer transfer unit 40 where the parts are mounted under the control of the controller.

Regarding Claim 19, the loop, as indicated by the arrows (in Fig. 4) shows not only that the printed circuit board is alternately carried from the first and second conveyors 43, 49, but is also alternately carried to the first and second multi-layer transfer units 40, 41. Burt further teaches mounting parts on the printed circuit board by a head unit (operator 34) and discharging the printed circuit board onto the second multi-layer transfer unit 41 under control of the controller when parts mounting is finished, or after the parts have been remounted because they have been determined as defective (see col. 4, lines 53-67).

Regarding Claim 20, the steps of Burt above, particularly that the printed circuit board is carried to the second conveyor after a "predetermined period of time".

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599.

The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, appearing to read 'A. Dexter Tugbang', is positioned above the printed name.

A. Dexter Tugbang
Primary Examiner
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July 17, 2003